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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,804	09/17/1998	PATRICK KALTENBACH	10980096-1	1533

22878 7590 10/15/2003

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EXAMINER

SINES, BRIAN J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/156,804

Applicant(s)

KALTENBACH ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 25, 26, 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 25, 28 and 30 is/are rejected.
- 7) ☒ Claim(s) 2, 4-8, 10-12 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

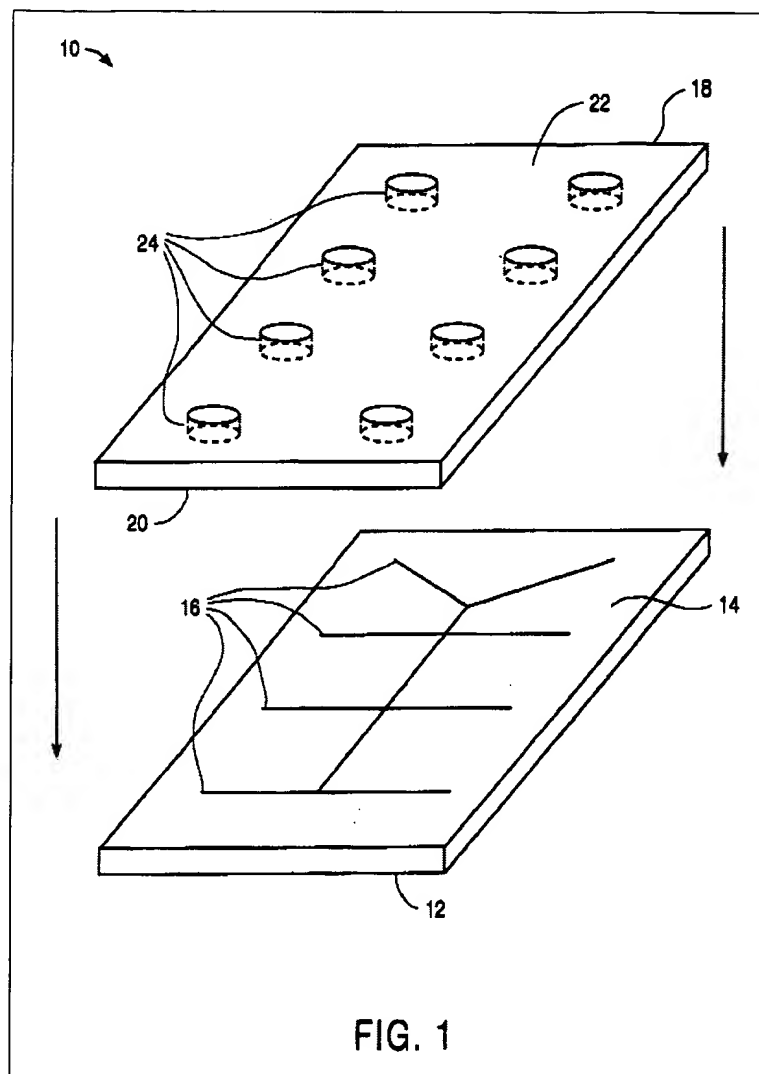
A person shall be entitled to a patent unless –

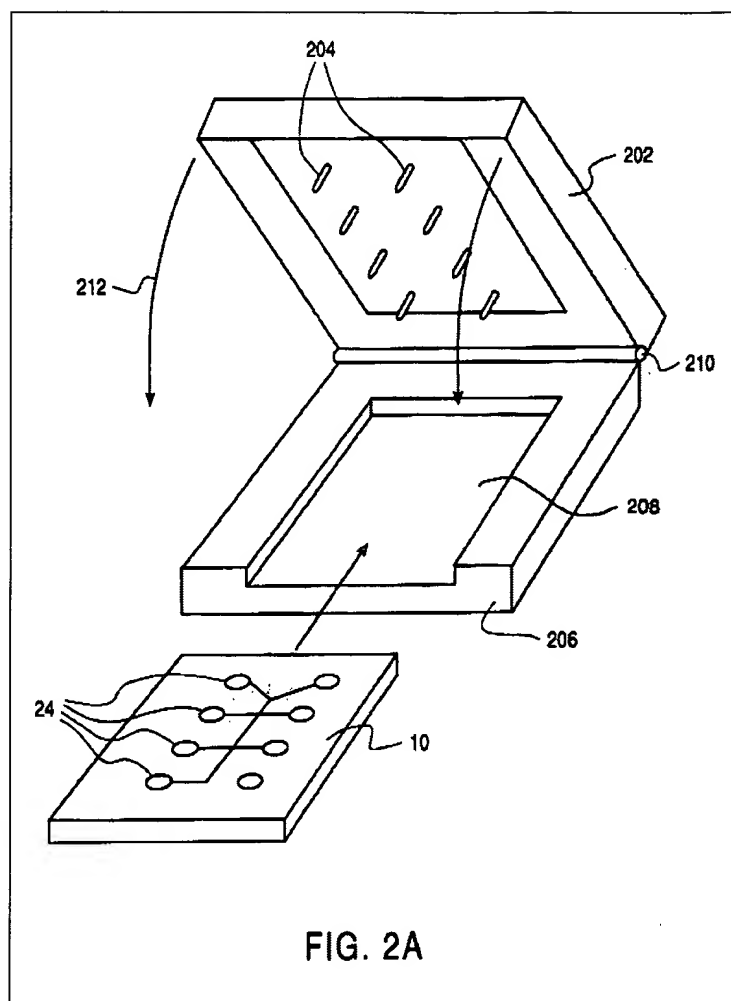
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 25, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow et al. (U.S. Pat. No. 5,989,401 A). Microfluidic devices are well known in the art for performing various analytical processes, such as sample separations and biochemical analyses (see col. 1, lines 1 – 56). In particular, Chow et al. teach a microfluidic apparatus comprising: a plurality of separation units (device 12 comprising upper surface 14) comprised of a solid substrate having a microchannel (microscale grooves or indentations 16) present in the surface thereof, wherein the microchannel in each separation unit is of a different length and forms a separation column or capillary that separates the analyte from the sample; a single reservoir unit (holes 14, which function as reservoirs for facilitating fluid or material introduction into the channels or chambers of the interior portion of the device, as providing ports at which electrodes may be placed) in the form of a plate; an external power source or electrical control system capable of generating an electric field different between electrically conductive probes (electrode pins 204) extending into the reservoir unit, wherein the power source is operatively connected to the reservoir unit for performing as an electrokinetic material transport system (see col. 5, lines 3 – 67; col. 6, lines 22 – 67; col. 9, lines 11 – 67; col. 10, lines 1 – 34; figures 1 &

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2A). Chow et al. teach that the fluid passage or microchannel system may be configured in a number of different formats, which include the specification of microchannel size dimensions, such as width, length, diameter, etc. (see col. 5, lines 3 – 28). Therefore, Chow et al. anticipate that the lengths of the microchannels may be modified within the apparatus.





Allowable Subject Matter

Claims 2, 4 – 8, 10 – 12 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Chow et al. teach that the body structure of the microfluidic devices described therein is typically fabricated from a number of discrete elements which, when assembled, form or define the integrated microscale channels and chambers of the microfluidic devices. Typically, the body

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structure comprises an aggregation of two or more separate layers which when appropriately mated or joined together, form the body structure of the microfluidic device of the disclosed device, e.g., containing the channels and/or chambers described therein. Typically, the microfluidic devices described therein comprise a top portion, a bottom portion, and an interior portion, wherein the interior portion substantially defines the channels and chambers of the device (see col. 5, lines 3 – 52; figure 1).

The cited prior art neither teach or fairly suggest the further incorporation of at least one separation unit, which is chip-shaped and formed from a first half and a second half each having a substantially planar surface facing and joining the other half, wherein at least one of the planar surfaces has a channel thereon such that the joining of the two surfaces forms the microchannel.

Response to Arguments

Applicant's arguments filed 7/15/2003 have been fully considered but they are not persuasive.

It should be noted that these claims are directed to an apparatus. Therefore, it is the structural limitations of the apparatus, as recited in the claims, which are considered in determining the patentability of the apparatus. These claims recite various process or use limitations and are accorded no patentable weight to an apparatus. For example, these claims recite how the apparatus is to function or operate, such as reciting the functional limitation that the plurality of separation units are each effective to carry out a different analytical application of interest, which does not impart any limitations to define the structure of the apparatus being claimed. Process limitations do not add patentability to a structure, which is not distinguished from the prior art. A recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP § 2114). The applicant is advised that, although, the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Therefore, although the prior art apparatus may not be what the applicant intends as their claimed invention, the claims do not exclude the teachings of the prior art.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (703) 305-0401. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700